

RESPONSE

Claims 1, 7, 13 and 18-19 have been amended. No claims have been cancelled. No new claims have been added. Claims 1, 3-16 and 18-22 remain pending in the application.

Support for Amendments**Claims**

Support for the amendments to claims 1, 18 and 19 is found in the specification on page 6, line 26 through page 7, line 9, and FIGs 8 and 9.

***Objections/Rejections
Under 35 U.S.C. § 112***

1.0 *The Examiner has objected to claims 1, 8, and 19 as non-enabled under 35 USC §112, paragraph 1.*

Applicant respectfully disagrees with the Examiner that claims 1, 8, and 19 are non-enabled in the disclosure. Applicant's claimed invention includes a main beam, first leg, and second leg defining a concavity accessible from the first transverse direction whereby the bracket is transversely nestable. Support for the claimed invention is found in Figures 1-4. Someone skilled in the art would know the claimed invention was nestable by considering the size, shape and configuration of the main beam, first leg, and second leg disclosed in Figures 1-4. While the Figures and written description do not illustrate or describe the brackets in a nested configuration, Figures 1-4 illustrate a bracket with the inherent function of nestability due to the size, shape, and configuration of the main beam, first leg, and second leg. Therefore, the function of nestability is inherently disclosed and the claims are amendable to recite the function of nestability. T.M.E.P. §2163.07(a).

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2.0 The Examiner has objected to claim 22 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention under 35 USC §112, paragraph 2.

Applicant respectfully disagrees that claim 22 is indefinite. Claim 22 claims "at least one primary rib formed within the main beam and the strut which ... (ii) longitudinally overlaps the first leg and the second leg ..." (Claim 22 of Applicant's application). Figures 1-4 and 5 support this claimed element. Looking at Figure 2 the rib (131) overlaps the first leg (110) in that the rib has a longitudinal length that starts proximate the strut (40) and the distal longitudinal end of the first leg (112) and runs in the second longitudinal direction toward the proximal longitudinal end of the first leg (111). Hence, the rib overlaps the first leg. Figure 3 illustrates the same configuration for the second leg.

***Objections/Rejections
Under 35 U.S.C. §103***

3.0 The Examiner has rejected claims 1, 3, 5, 10-13, 16, and 18-21 as obvious over Ramser (United States Patent No. 3,053,491) in view of Schwartz (United States Patent No. 3,041,033).

Summary of Cited References

Ramser discloses an eaves trough support bracket comprising a main beam, first leg, and second leg. The lower portions of the first and second legs are bent inward along a longitudinal bend line so as to form a nearly enclosed base on the bracket. The first and second legs also extend in the second transverse direction with the transverse height of the legs remaining substantially unchanged along the longitudinal length of the bracket.

Schwartz discloses a shelving bracket comprising a main beam, first leg, and second leg. The main beam, first leg, and second leg define a concavity accessible from a first transverse direction.

Summary of Claimed invention

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A First Embodiment of the present claimed invention (claims 1, 3-16, and 18-20) is directed to an eaves trough support bracket having a first leg extending in a second transverse direction from the first edge of a main beam with a proximal longitudinal end substantially transversely aligned with a proximal end of the main beam and a second leg extending in the second transverse direction from a second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam. The main beam, first leg, and second leg define a concavity accessible from a first transverse direction whereby the support bracket is transversely nestable. A connection element extends in a first transverse direction from the distal end of the main beam with a longitudinally extending tab transversely spaced from the main beam in the first transverse direction a distance of about 0.4 to 0.6 inches from the first surface of the main beam.

A Second Embodiment of the present claimed invention (claim 21) is directed to an eaves trough support bracket having a main beam, first leg and second leg. The first and second legs extend in a second transverse direction. The first leg has a transverse height that tapers in the second transverse direction with a height at the longitudinal center of the main beam less than one half the transverse height at the proximal longitudinal end of the first leg. The second leg has a transverse height that tapers in the second transverse direction with a height at the longitudinal center of the main beam less than one half the transverse height at the proximal longitudinal end of the second leg.

Legal Basis

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

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expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

CITED REFERENCES LACK MOTIVATION
TO MODIFY THE PRIOR ART
TO ACHIEVE THE PRESENT INVENTION

In order to determine the propriety of an obviousness rejection, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution, combination, or modification. In re Linter, 458 F.2d 1013, 173 U.S.P.Q. 560, 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and produce the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, M.P.E.P. § 2143.01.

FIRST EMBODIMENT

Ramser and Schwartz do NOT provide the requisite motivation to modify the eaves trough bracket of Ramser to have (i) an open base as disclosed in Schwartz, nor (ii) a connection element on the distal end of the main beam with a longitudinally extending tab transversely spaced from the main beam a distance of about 0.4 to 0.6 inches from the first surface of the main beam.

Open Base

While Schwartz discloses a bracket with an open base, the bracket is for shelving and the written description indicates the open base is used for positioning the bracket over wall studs. Schwartz does not disclose a bracket that is nestable. Persons skilled in the art would NOT normally look to shelving bracket technology to design an eaves trough gutter bracket. Due to the highly divergent uses of the Ramser and Schwartz devices, persons skilled in the art would NOT be motivated to combine the teachings of these references. It is only through the use of forbidden hindsight that a motivation is found to combine these references.

Upwardly Spaced Connection Element Tab

The First Embodiment of the Present Claimed Invention is configured and arranged with a "return tab" on the connection element which is transversely spaced from the main beam a distance of about 0.4 to 0.6 inches from the first surface of the main beam. Such spacing of the return tab from the main beam positions the main beam a distance into the gutter effective for hiding the main beam from ground level view even when the gutter begins to sag. It is well known within the industry that the curbside appeal of a home is substantially diminished if the gutter brackets are visible from ground level. The First Embodiment of the Present Claimed Invention significantly reduces the likelihood that the brackets will become visible from ground level even if the gutter begins to sag.

Ramser discloses a gutter bracket with a connection element on the distal end of the bracket for engaging a lip [5] on the upper edge of the front wall of the gutter [4]. The connection element is a hook [11] with a longitudinally extending return portion which is transversely spaced from the main beam a distance barely sufficient to accommodate passage of the lip [5] on the gutter between the horizontal web [7] of the bracket and the return portion of the hook [11] (e.g., about 0.1 to 0.2 inches). See, FIG. 3. Ramser minimizes the transverse height of the gap formed by the hook [11] as the forward end of the bracket (i.e., the forward ends of the horizontal web [7] and the vertical sides [8]) must fit snugly against the front wall of the gutter [4] in order to prevent the bracket from damaging the gutter when the fastener [20] is driven into the rear wall of the gutter [1]. See, FIG 4. Accordingly, Ramser does not disclose, teach or suggest a connection element on the distal end of the main beam wherein the "return tab" is transversely spaced from the main beam a distance of about 0.4 to 0.6 inches from the first surface of the main beam.

Schwartz is not directed to a gutter bracket and therefore does not provide as "return tab".

SECOND EMBODIMENT

Ramser and Schwartz do NOT provide the requisite motivation to modify the eaves trough bracket of Ramser to have a first and second leg that have transverse heights that taper in the second

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transverse direction with a transverse height at the longitudinal center of the main beam of less than one half the transverse height at the proximal longitudinal end of the second leg. While Schwartz discloses a bracket with tapering legs, the bracket is for shelving and does not disclose a required ratio of the taper. Persons skilled in the art would NOT normally look to shelving bracket technology to design an eaves trough gutter bracket. Due to the highly divergent uses of the Ramser and Schwartz devices, persons skilled in the art would NOT be motivated to combine the teachings of these references. It is only through the use of forbidden hindsight that a motivation is found to combine these references.

4.0 *The Examiner has rejected claims 4, 6-9, 15, and 22 as obvious over Ramser (United States Patent No. 3,053,491) in view of Schwartz (United States Patent No. 3,041,033) in further view of Odekirk (United States Patent No. 4,294,422).*

Summary of Cited References

Ramser discloses an eaves trough support bracket comprising a main beam, first leg, and second leg. The lower portions of the first and second legs are bent inward along a longitudinal bend line so as to form a nearly enclosed base on the bracket. The first and second legs also extend in the second transverse direction with the transverse height of the legs remaining substantially unchanged along the longitudinal length of the bracket.

Schwartz discloses a shelving bracket comprising a main beam, first leg, and second leg. The main beam, first leg, and second leg define a concavity accessible from a first transverse direction.

Odekirk discloses an eaves trough support bracket comprising a main beam, a first longitudinally elongated side rib, second longitudinally elongated side rib, and connection element. The connection element has a strut and tab. A rib is also disclosed along a bend line along the transition line from the main beam to the strut. The first and second side ribs extend in the second transverse direction with the transverse height of the side ribs remaining substantially unchanged along the longitudinal length of the bracket.

Summary of Claimed invention

A **First Embodiment** of the present claimed invention (claims 1, 3-16, and 18-20) is directed to an eaves trough support bracket having a first leg extending in a second transverse direction from the first edge of a main beam with a proximal longitudinal end substantially transversely aligned with a proximal end of the main beam and a second leg extending in the second transverse direction from a second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam. The main beam, first leg, and second leg define a concavity accessible from a first transverse direction whereby the support bracket is transversely nestable.

A **Third Embodiment** of the present claimed invention (claim 22) is directed to an eaves trough support bracket having a main beam, connection element, first leg, second leg, a first bend line, second bend line, at least one primary rib, and at least one secondary rib. The connection element includes a strut and a tab. The at least one primary rib is formed within the main beam and the strut which extends across and substantially perpendicular to the first bend line and overlaps the first and second leg improving the strength of the bracket. The at least one secondary rib is formed within the strut and tab and extends across and substantially perpendicular to the second bend line and transversely overlaps the at least one primary rib improving the strength of the bracket.

Legal Basis

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

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In order to determine the propriety of an obviousness rejection, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution, combination, or modification. In re Linter, 458 F.2d 1013, 173 U.S.P.Q. 560, 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and produce the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, M.P.E.P. § 2143.01.

FIRST EMBODIMENT

Ramser, Schwartz, and Odekirk do NOT provide the requisite motivation to modify the eaves trough bracket of Ramser to have (i) an open base as disclosed in Schwartz, nor (ii) a connection element on the distal end of the main beam with a longitudinally extending tab transversely spaced from the main beam a distance of about 0.4 to 0.6 inches from the first surface of the main beam. Odekirk is not nestable and discloses a main beam with a portion which extends above the "return tab" on the connection element. Accordingly, claims 4, 6-9 and 15 are *patentable over* Ramser, Schwartz, and Odekirk for the reasons set forth in paragraph 3.0 above addressing patentability of the First Embodiment of the Present Claimed Invention over Ramser and Schwartz.

NEITHER RAMSER, SCHWARTZ, NOR ODEKIRK
TEACH OR SUGGEST ALL OF THE CLAIM
LIMITATIONS OF THE CLAIMED INVENTION.

THIRD EMBODIMENT

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Ramser discloses an eaves trough support bracket. The Ramser bracket comprises a main beam and connection element. The Ramser bracket has no ribs. Schwartz discloses a shelving bracket comprising a main beam and two legs. The Schwartz bracket has no ribs. Odekirk discloses an eaves trough support bracket. The Odekirk bracket comprises a main beam and connection element. The element has a strut and tab wherein a rib formed is along a bend line along the transition line from the main beam to the strut. The Third Embodiment of the present claimed invention is directed to a bracket with overlapping ribs. Neither Ramser, Schwartz, nor Odekirk disclose, teach, or suggest overlapping ribs effective for eliminating points of weakness in the bracket.

CONCLUSION

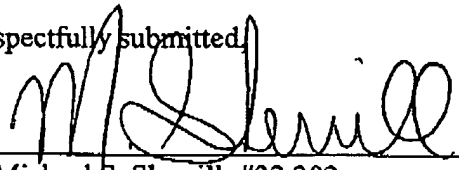
Applicant respectfully submits that all pending claims (claims 1, 3-16 and 18-22) are in condition for allowance.

Date

26 Aug 03

Respectfully submitted,

By


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